

the manufacture of the product of Claim 1 ..."). Similarly, in a situation like a plug and socket example, a claim to the one part referring to the other cooperating part, for example, "plug for cooperation with the socket of Claim 1 ..." is not a dependent claim as it does not expressly contain the limitations of the earlier claim from which it depends, rather it only has a functional relationship to that earlier claim.

Interpretation of Claims

5.20 Claims should be interpreted the same way for both search and examination purposes. Each claim should be read giving the words the ordinary meaning and scope which would be attributed to them by a person skilled in the relevant art, unless in particular cases the description gives the words a special meaning, by explicit definition or otherwise. See the appendix to this chapter for further guidance with regard to the interpretation of claims.

"Use" Claims

5.21 A claim to a substance or composition for a particular use should generally be construed as meaning a substance or composition which is in fact suitable for the stated use; a known product which *prima facie* is the same as the substance or composition defined in the claim, but which is in a form which would render it unsuitable for the stated use, would not deprive the claim of novelty, but if the known product is in a form in which it is in fact suitable for the stated use, though it has never been described for that use, it would deprive the claim of novelty. For example, a claim to a known substance or composition for the first use in surgical, therapeutic and/or diagnostic methods that is presented in a form such as: "substance or composition X" followed by the indication of the use, for instance "... for use as a medicament", ... as an antibacterial agent" or "... for curing disease Y" will be regarded as restricted to the substance or composition when presented or packaged for the use. See also paragraph 5.22. See the appendix to this chapter for further guidance with respect to use claims, and for an explanation of when an Authority may regard a "use" claim as equivalent to a "process" claim.

Preamble

5.22 The effect of the preamble on the evaluation of the elements of a claim for search and examination purposes should be determined on a case by case basis in light of the facts in each case. During search and examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, a difference in process steps) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. In two-part claims as defined in Rule 6.3(b), the preamble is regarded as a limitation on the scope of the claim.

5.23 If a claim commences with such words as "Apparatus for carrying out the process; etc., ..." this must be construed as meaning merely apparatus suitable for carrying out the process. An apparatus which otherwise possesses all of the features specified in the claim, but which would be unsuitable for the stated purpose or which would require modification to enable it to be so used, should not normally be considered as coming within the scope of the claim. For example, a claim recites a machine for cutting meat comprising apparatus limitations. The claim language "machine for cutting meat" sets forth only the function of the apparatus (that is, for cutting meat) without any positive structural limitations. Such language would not be given any weight in assessing novelty and inventive step as long as the prior art cutting machine was capable of cutting meat. In this case, one should treat the words "for cutting meat" merely as limitation to a machine adapted to cut meat. Thus, one would look to

BEST AVAILABLE COPY

Even for different
formulations are equal
accuracy to specialists

Suppl. 5 (to USPTO)

PART C "EPO Guidelines" IV:11

first medical use need not fulfil all other requirements of patentability, especially that of inventive step (see T 128/82, OJ 4/1984, 164).

A claim in the form "Use of substance or composition X for the treatment of disease Y ..." will be regarded as relating to a method for treatment explicitly excluded from patentability by Art. 52(4) and therefore will not be accepted.

If an application discloses for the first time a number of distinct surgical, therapeutic or diagnostic uses for a known substance or composition, normally in the one application independent claims each directed to the substance or composition for one of the various uses may be allowed; i.e. an a priori objection of lack of unity of invention should not, as a general rule, be raised (see III, 7.6).

Art. 82

A claim in the form "Use of a substance or composition X for the manufacture of a medicament for therapeutic application Z" is allowable for either a first or "subsequent" (second or further) such application ("second medical use" type of claim or "Swiss-type" claim), if this application is new and inventive (cf. G 5/83, OJ 3/1985, 64). The same applies to claims in the form "Method for manufacturing a medicament intended for therapeutic application Z, characterised in that the substance X is used" or "the substantive equivalents thereof" (see T 958/94, OJ 6/1997, 241). In cases where an applicant simultaneously discloses more than one "subsequent" therapeutic use, claims of the above type directed to these different uses are allowable in the one application, but only if they form a single general inventive concept (Art. 82). Regarding use or method claims of the above type, it should also be noted that a mere pharmaceutical effect does not necessarily imply a therapeutic application. For instance, the selective occupation of a specific receptor by a given substance cannot be considered in itself as a therapeutic application; indeed, the discovery that a substance selectively binds a receptor, even if representing an important piece of scientific knowledge, still needs to find an application in the form of a defined, real treatment of a pathological condition in order to make a technical contribution to the art and to be considered as an invention eligible for patent protection (see T 241/95, OJ 2/2001, 103). See also III, 4.14, for the functional definition of a pathological condition.

2. Methods for treatment of the human or animal body; diagnostic methods

With regard to methods for treatment of the human or animal body by surgery or therapy, or diagnostic methods practised on the human or animal body, it should be noted that products, in particular substances or compositions, for use in any of these methods, are not excluded from patentability, provided that the use of the product for any such method is not comprised in the state of the art (see also C-IV, 4.2). It should be noted that a claim in the form "Use of a substance or composition X for the manufacture of a medicament for therapeutic application Z" may be allowable for either a first or "subsequent" such application (cf. C-IV/4.2).

Even if a claim is drafted as a method of medical treatment and is for this reason not directed to patentable subject-matter, a meaningful search may be possible if the determining technical feature is the effect of the substance, which can be searched. If, however, specific method features are present (e.g. dosing instructions for the user, combination of pharmaceutical with physical treatment), a meaningful search may not be possible. In cases of doubt the Search Division should carry out the search to the extent that this is possible in the available documentation. However, regardless of whether such claims are searched or not, the applicant's attention should be drawn on the search opinion (if applicable, see XII, 8) to the exclusion of such subject matter from industrial application (see XII, 3).

Part B

Chapter 2 VIII

Art. 52(4)
Art. 54(5)

W. J. Bay